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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,813	03/22/2001	Allen R. DeCotiis	PNX1P003	5834

7590 05/09/2005
C. DOUGLAS MC DONALD, ESQ.
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TAMPA, FL 33601-3239

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,813

Applicant(s)

DECOTIIS ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-18 have been examined.

Response to Arguments and Amendments

2. Applicant is of the opinion that Rothman et al. system is insufficient as prior art because Rothman et al. teach away from surveys and therefore cannot be combined with the data gathering method of Schulze Jr. The Examiner respectfully disagrees. Initially, Rothman et al. disclose gathering customer data via an interactive process, such as through the use of telephone calls, direct mailing, e-mail contact, or other methods of contacting a customer. Rothman et al. also teach collecting customer information when a customer fills out an application for service, such as information about customer purchases, account activity, and interaction with the financial institution or entity gathering the information; and that customer purchase information may be gathered in other manners, based on the products and services to be potentially offered to a customer ('168, column/line 3/65-4/17). Therefore, it would have been obvious to one of ordinary skill to use the standardized interactive data collecting method of Schulze Jr. (e.g. surveys) in order collect customer information ('564, column 2, lines 23-30; column 6, lines 46-53; column 8, lines 58-65; column 10, lines 47-52; column 15, lines 50-56). Regarding Examiner's "reasons to combine", the fact

that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious (*Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985)). Nonetheless, one of ordinary skill would have instantly realized the benefit of such a combination as Rothman et al. state,

Standardization of customer purchase information allows an entity, such as, for example, a financial institution or a credit card provider, to better meet the needs of the customer. The more information gathered about a customer, the easier to tailor offers of products and services to what a particular customer really wants or needs ('168, column 4, lines 17-22)

Therefore, as Rothman et al. do not teach away from the use of surveys and suggests a reason to implement their system with standardized interactive data gathering methods such as surveys, Rothman et al. is clearly valid prior art.

Regarding the appliance of "101", the added language does not overcome the rejection as the claim continues to produce an outcome (i.e. a score or propensity) without a practical application, and was produced without transformation of the data by a machine, such as a computer. Hence the claimed invention does not produce useful, concrete and tangible result (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998)).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-18 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Applicant's claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed, hence, the claimed invention does not promote the progress of science and the useful arts. Claim 1 is merely an abstract idea (e.g. a mathematical formula) as it is not tied to the computer arts. Claim 7 recites "computer code", while claim 13 recites "logic". However, the computer code is not stored on a computer readable medium and the "logic" is not embedded in a computer, for example, that is used to implement the claimed system. Further, the "usefulness" of claims 1, 7 and 13 is not apparent. Specifically, the outcome (i.e. a score or propensity) of the Applicant's claimed processing is merely a number without a practical application, and was produced without transformation of the data by a machine, such as a computer. Hence the claimed invention does not produce useful, concrete and tangible

result (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998)).

Claims 3, 5, 9, 11, 15 and 17 refer to a network or internet. However, these claims are directed to collecting "individual information" or "information" limitations that are not found in independent claims 1, 7 or 13 and therefore, are also lacking in utility.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothman et al., U.S. Patent No. 6,505,168 in view of Schulze, Jr., U.S. Patent No. 6,233,564.

As per claims 1-18, Rothman et al. teach creating a model, calculating a score, that indicates a propensity, based on the model, and sorting and ranking individuals based on the score (figures 5 and 6; column/line 6/66-7/20)

Rothman et al. also teach a model that sets forth a plurality of characteristics and a weight (i.e. equal) of each of the characteristics for calculating the score

(column 4, lines 35-55; column 5, lines 38-64). However, Rothman et al. do not specifically recite using surveys to collect information on an intent to purchase a particular product. Schulze Jr. teaches a method for collecting information over a network such as the internet (abstract; figures 1 and 2; column 5, lines 32-59). Specifically, Schulze Jr. teaches asking customers about "anticipated major purchases" (column 2, lines 23-30; column 6, lines 46-53; column 8, lines 58-65; column 10, lines 47-52; column 15, lines 50-56). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Rothman et al. and Schulze Jr. in order to allow goods and services providers to more effectively and directly target consumers ('564, column 2, lines 23-30).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

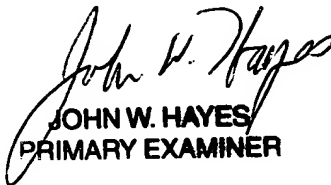
or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Calvin Loyd Hewitt II

April 28, 2005


JOHN W. HAYES
PRIMARY EXAMINER